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NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ALEXANDRIA VA 22201

EXAMINER	
ALVO, M	
ART UNIT	PAPER NUMBER
1731	24

DATE MAILED: 11/29/99

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

**NOTIFICATION OF NON-COMPLIANCE WITH THE
REQUIREMENTS OF 37 C.F.R. § 1.192(c)**

The response to Notification of Non-Compliance and contingent petition for review, filed August 23, 1999, is being treated as a request for reconsideration as set forth under 37 CFR 1.181.

Applicant has argued that the second and third paragraphs of page 20 of the brief argues each and every claim through the statement, "Nor is there any reason why any one of ordinary skill in the art employ what is specifically called therein (or any prima facie case established in the Final Rejection)". Such a statement does not meet Applicants burden to argue why the claims are separately patentable. This is nothing more than "merely pointing out differences in what the claims cover", it "is not an argument as to why the claims are separately patentable" as required by 37 CFR 1.192(c). Claims 13, 15 and 21 have not been argued at all. Applicant's argument that claims 3, 18, 20 and 27 were argued earlier (for example footnote on page 17 of the brief) is not convincing as this footnote only refers to claim 27 and only refers to a "kappa number of 25.9

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or less". It does not refer to claims 3, 18 or 20 and thus does not argue why claims 3, 18 and 20 are separately patentable. It does not argue why the pH of claim 27 is unobvious over the art. As set forth in the final rejection, page 3, line13, "See EP 511 695, page 3, lines 48-54 for treating hardwood kraft pulp with a kappa No. As low as 5". There is no argument as to why the "25.9 or less" of claim 27 is unobvious over the kappa number of "5" of EP 511 695. Claims 22-28 have not been separately argued.

The Appeal Brief filed 5-20-99 is defective for failure to comply with one or more provisions of 37 CFR § 1.192(c). See 1173 O.G. 62, April 11, 1995.

37 CFR § 1.192(c) requires the following items to be included in the appellant's brief:

- (1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.
- (2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.
- (3) *Status of claims.* A statement of the status of all the claims, pending or canceled, and identifying the claims appealed.
- (4) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.
- (5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.
- (6) *Issues.* A concise statement of the issues presented for review.
- (7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single

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claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(I) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) describe the subject matter defined by each of the rejected claims,

(B) enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(I) to (iv) of this section, the argument shall specify the errors in the rejection and the

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specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix*. An appendix containing a copy of the claims involved in the appeal.

The Brief on Appeal filed 5-20-99 does not comply with the provisions of 37 C.F.R. § 1.192(c)(7) because the brief contains the statement that all of the claims are independently distinct from each other but, in the arguments appellant does not explain why all the claim are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. Claims 13, 15 and 21 have not been argued at all. Claims 3, 18, 20 and 27 have been argued as a single group, there is no argument as to why the claims are separately patentable. Claims 22-28 have not been separately argued. Applicant merely states that "nor is there any reason why one of ordinary skill in the art would employ what is specifically called for therein". Applicant has not argued as to "why claims 22-28 are separately patentable.", see last paragraph under "(7) Grouping of claims" above.

A proper response to this letter would be a Petition, or new brief complying with 37 CFR 1.192.

Appellant is required to comply with provisions of 37 C.F.R. § 1.192(c). APPLICANT IS GIVEN A TIME LIMIT OF ONE MONTH FROM THE DATE OF THIS LETTER OR ANY TIME REMAINING IN THE PERIOD UNDER 37 CFR 1.192(a) FOR FILING A NEW COMPLETE BRIEF. If a new brief that fully complies with 37 CFR 1.192(c) is not timely submitted, the appeal will be dismissed as of the date of expiration of the period provided by 37 CFR 1.192(a). No extension of this one month time limit may be obtained under either 37 CFR

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1.136(a) or (b) but the original two-month period under 37 CFR 1.192(a) for filing the brief may be extended under 37 CFR 1.136(a) up to six months from the date of the Notice of Appeal.

A proper response to this letter would be a Petition, or new brief complying with 37 CFR 1.192.


When filing an **"Official"** FAX in Art Unit 1731, please indicate in the Header (upper right) **"Official"** for papers that are to be entered into the file. The **"Official"** FAX phone number for this Art Unit is **(703) 305-7718** for all papers except amendments after final, for amendments after final the FAX number is 703-305-3599. When filing an **"Unofficial"** FAX in Group 1730, please indicate in the Header (upper right) **"Unofficial"** for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The **"Unofficial"** FAX phone number for this Art Unit (1731) is **(703) 305-7115**.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:30 AM - 3:00 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.

MSA
November 24, 1999


STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731